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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,793	12/24/2003	Katsuto Tanahashi	032206	9788
38834	7590	06/22/2005	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			MONDT, JOHANNES P	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/743,793	Applicant(s) TANAHASHI ET AL.	
	Examiner Johannes P. Mondt	Art Unit 2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11,13 and 14 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 15 - 18 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected manufacturing method, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/20/2005.

Information Disclosure Statement

The examiner has considered the items listed in the Information Disclosure Statement filed 3/25/2004. A signed copy of Form PTO-1449 is herewith enclosed.

Claim Objections

2. **Claims 1-14** are objected to because of the following informalities:

(a) the wording "semiconduct r" in claim 1 should be replaced by:
"semiconductor" (line 1).

(b) the wording "lower" (line 7 of claim 1) should be replaced by "and lower".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 5, 6 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonehara et al (US 2003/0159644 A1) in view of prior art as admitted

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by Applicants ("APAA"). Yonehara et al teach a semiconductor substrate 1 ([0075] and [0113]) comprising a front face and a rear face that are both mirror-polished ([0095]), wherein said semiconductor substrate contains boron at a concentration in the range $1 \times 10^{17} - 10^{20} \text{ cm}^{-3}$, which range overlaps the claimed range in the sub-range $10^{17} - 2 \times 10^{17} \text{ cm}^{-3}$. A *prima facie* case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art or when the ranges of a claimed composition do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties. In re Peterson, 65 USPQ2d 1379 (CA FC 2003). Yonehara et al do not necessarily teach the limitation that said semiconductor substrate meets a criterion of "an SFQR value $\leq 70 \text{ nm}$ as a flatness of the front face". However, as admitted by Applicants as many as 40% of all conventionally produced wafers satisfy said criterion and therefore, by rule of statistics all one of ordinary skills in the art has to do is make enough of said wafers in order to be certain to have one that satisfies said criterion. With regard to claim 14, in addition Yonehara et al teach a semiconductor element formed on the front face of said semiconductor substrate (solar battery: see Figures 16 and [0072]).

On claim 2: a crystal layer 3 is provided on the front face ([0149]).

On claim 5: the crystal layer is a silicon crystal layer ([0078]) formed by epitaxial growth ([0149]).

On claim 6: the crystal layer is a silicon-germanium alloy crystal layer ([0078]; see also Embodiment 6 ([0189])).

5. **Claims 7-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonehara and APAA as applied to claim 2 above, and further in view of Fitzgerald (US 2002/0123167 A1). As detailed claim 2 is unpatentable over Yonehara et al in view of APAA. Neither necessarily teach the claimed layered structure of SiGe and Si. However, (a) there is a specific suggestion by Yonehara et al that a layered structure of SiGe on silicon could be used to generate stress in an SOI structure ([0411]-[0412]), while Fitzgerald teaches an SOI structure with a layered SOI composition, in particular SiGe on Si (Figure 1) for the specific purpose to enhance electron mobility (see "Background of the Invention"). Motivation to follow the suggestion by Yonehara et al and the teaching by Fitzgerald immediately derives from the improved electron mobility and consequent higher operational speed.

On claims 8 and 9, both Yonehara et al ([0411]-[412] and Fitzgerald ([0032] and Figures 4) teach the silicon layer to be formed in an SOI structure, i.e., inherently a structure in which the silicon crystal layer is separated by a silicon oxide layer, i.e., said semiconductor substrate is an SOI substrate wherein the crystal layer is an upper silicon crystal layer separated by a silicon dioxide layer (loc.cit.).

On claim 10: while Yonehara et al teach SIMOX as a method in the prior art for making an SOI substrate ([0006]) Applicant is reminded that the limitation of claim 10 fails to further limit the device and instead only further limits the method of making. Therefore, the further limitation defined by claim 10 fails to distinguish over the prior art.

On claim 11: similarly, while Yonehara et al teach bonding steps the limitation of claim 11 fails to further limit the device but instead only limits its method of making. Hence the further limitation fails to distinguish over the prior art.

6. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonehara et al and APAA as applied to claim 1 above, and further in view of Steckl et al (5,759,908). As detailed above, claim 1 is unpatentable over Yonehara et al in view of APAA. Neither necessarily teach the further limitation defined by claim 13. However, it would have been obvious to include SiC as a substrate material for an SOI in view of Steckl et al, who teach silicon carbide SOI structures (title, abstract) for the specific purpose of inter alia its higher breakdown voltage (see col. 1, l. 10-22). Motivation to replace the silicon substrate with the silicon carbide substrate derives immediately from said higher breakdown voltage.

Allowable Subject Matter

7. **Claims 3, 4 and 12** are objected to as being dependent upon a rejected base claim, but would be allowable, subject to compliance with the condition for removal of the objections to claims 1-14 for minor informalities as delineated above, if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter:

(a) with regard to claims 3 and 4, the inequality as claimed for the minimum boron concentration involving the thickness has not been found in the prior art.

(b) Yonehara et al teach a 600 nm thick rear back shield formed naturally ([0284-
[0285]), while within the context of the invention as recited in claim 1 the further
limitation as defined by claim 12 has not been found in the art.

Conclusion


Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Johannes P. Mondt whose telephone number is 571-
272-1919. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number
for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

JPM
June 13, 2005

Patent Examiner:


Johannes Mondt (Art Unit: 2826).